

REMARKS

Claims 1-19, 21-23, and 28 are cancelled. Claims 20, 24, 25, 27, and 29 are amended. New claims 30-37 are added.

The Examiner's comments and thoughts have been carefully considered. Based upon the same and the details below favorable reconsideration is respectfully requested. The application is now believed to be in condition for allowance. No new matter has been added. Support for the amendments is found in the original claims, specification, and drawings.

1. Priority under 35 U.S.C. §119 (Foreign Priority) and Drawing in Application Papers

Applicants thank the Examiner for acknowledging the Priority Claim and presume also the acceptance of the drawing in the formal record.

2. Rejection of Claims 17 and 22 under 35 USC §112, first paragraph.

Beginning on page 3 and extending to page 4 of the present action the Examiner raises concerns under §112. Because the only specificity in the rejection relates to claims 17 and 22, and specifically to 'the examples of 'ceramic composite' and 'non-distal end' these are the only items that can be addressed by Applicant.

The Examiner argues on page 4 of the action specifically against the phrase 'ceramic composite' in claim 17, and posits on page 2 of the action (2nd paragraph) that "ceramic composite" is broader than "threads of graphite" clearly noted in the translation, along with discussions of differing types of conductive materials. The Examiner's rejection is respectfully traversed and reconsideration is requested in view of the present amendment to claim 17.

The Examiner argues on page 4, second paragraph, that the phrase non-distal end is not found in the specification and necessarily therefore that claim 22 is indefinite for this reason. The Applicant had adequately clarified this matter in page 8, second paragraph of their response of November 7, 2007, (lines 12-19), the entire contents of which are again repeated herein below, and

In Re Application of Christoph KURTH

the points raised by the Application have not been further addressed in the instant action. It is again noted that:

(b) Claim 22 notes a “non-distal” end of a stump as being one of a set of “distal” and “non-distal” ends for a single noun. The entire disclosure provides support to the subject matter of supports for amputees and the drawing and discussion readily note the discussion of a “distal” end of a stump relating to the inner portion of the support. Those of skill in the art will readily recognize the subject matter to which it pertains (for example the liner is discussed as having a distal and hence also non-distal end is disclosed). It is therefore proposed that those of skill in the art will also readily recognize that by logical analysis the opposite of the “distal” end of the stump subsumes the “non-distal” end of the stump without reaching. Since those of skill in the art will also recognize that the liner covers, in part, both the distal end and the non-distal end of any limb inserted therein (see the drawing), no further discussion is believed to be necessary.

There is no requirement in §112 for the literal existence of a descriptive word (such as non-distal) to be in the written specification where a drawing and the discussion support both the recognition and existence of a distal and a necessarily obvious opposite non-distal end. The cited MPEP §714.02 requires only support for the language in the claim, and this was readily supplied earlier and has not been challenged in a manner that would allow Applicant to respond.

The Examiner appears to have no difficulty with the phrase “distal” and therefore necessarily should have no difficulty with the phrase non-distal (as representing a portion that is not the distal end). Similarly, Applicant could have readily chosen the opposites “first end” and “second end” or “first end” and “non-or-not-first end” descriptively as their own lexicographers. Should the present rejection be maintained, it is Applicants position that (1) the Examiner’s rejection is insufficiently specific as to the standard applied, the specific support necessary, and that under 35 USC 132/37 CFR 1.104(a)(2) the explanation provided in the record is incapable of informing the Applicant of the propriety of continuing the prosecution in this manner without clarification. Should the present

In Re Application of Christoph KURTH

rejection be maintained a request is made for an executed evidentiary offer of proof that is admissible and challengeable as evidence-in-record at appeal that the entire disclosure lacks support for the phrase non-distal. In view of the above discussion, Applicant respectfully proposes that they have sufficiently supported the language, have fully responded to the Office position (as best possible), and that the concerns regarding the language of the Applicant-lexicographer have been overcome. Notice to that effect is earnestly solicited.

On page 2 of the present action, at the end of the second paragraph a comment is raised by the Examiner regarding §112 that is not repeated in the Claim Rejection section regarding ‘electrically conductive region’. As no rejection is raised or maintained no response is required, however it appears that the Examiner considers element 5 in the drawing to be the sole ‘electrically conductive region’ and this is unduly restrictive. As noted in the Translation on page 3, first full paragraph “a conductive region is arranged between the stump and the layer of conductive material...”. While the description of element 5 is of an electrically conductive region, nothing in the specification so restricts or limits the claims to an element such as the exemplary element 5 shown. Indeed, the specification’s broadest interpretation for ‘an electrically conductive region’ is a region arranged between the stump and the layer of conductive material (which would optionally include liner cup 3, matrix 2, pin adaptor 4, and region 5. Should any specific concern remain regarding this phrase, absent any limitations in the claims, a request is made

3. Rejection of claims under 35 USC §101

Claims 15-29 stand presently rejected under §101 as directed to non-statutory subject matter. Applicant respectfully traverses and requests specific clarification regarding the complete language in the claim as well as reconsideration and withdraw of this rejection. It is argued that based upon 35 USC 132 insufficient specificity has been provided to applicant regarding the entire claim language selection to judge the propriety of continuing the prosecution.

It appears that claim language sections have been taken in a limited way, out of context, and thereby lack the specific elements that avoid the concern the Examiner raises. Viewing the entire

In Re Application of Christoph KURTH

claim clauses in context easily avoids the concerns.

First, it is well recognized that claim language and claim preambles may easily be employed, in a descriptive way relative to non-claimed subject matter as to position, shape, or location, or a purpose of an apparatus in relation to a body part etc., without claiming the body part itself.

The USPTO records are replete with such records, for example at the cited US 4,664,118 claim 10 “An electrical therapeutic assembly for reducing pain and edema in a human body, said assembly comprising (a) a woven.....flexible to envelope an area of the (or said) body in which there is pain....”. Here the preamble cites a purpose statement for the apparatus (therapeutic assembly, much like citing a purpose for the present liner) and includes a purpose or relationship language statement “for reducing ... in a human body” (like the present “for a limb stump).

Similarly in US 6,517,585 notes “A lower limb prosthesis for an above-knee amputee, having an adaptive control system which comprises a knee flexion control device arranged to resist flexion at a knee joint, and an electronic processing circuit electrically coupled to sensor means and a control device for automatically adjusting the hydraulic and pneumatic resistance to knee flexion” . The related classes and subclasses are full of similar examples involving body or limb phrases, and using body/limb language in a descriptive or relationship manner, and Applicants propose that the present claims achieve the same standard under 35 USC 101 and request reconsideration.

For example in cited claim 15:

A supporting sleeve for a body stump having at least a distal end, namely a liner, comprising: a sleeve member defining a concave shape to bound at least a portion of said distal end of said body stump;

For example in the cited claim 29:

A supporting sleeve for a body stump, namely a liner, comprising: a sleeve member having a shape for bounding at least a distal end of said body stump....

Applicant as been unable to locate a requirement under §101 preventing the claiming of non-body elements, and the use of ‘body’ type language relating to the existence, shape, position, or purpose (‘for’) language. A request was made earlier to provide a more specific citation (35 USC §132) prohibiting such language so that Applicant may more adequately respond, and no such citation was provided.

The claims do not require the existence of a “stump” but position other elements in the construction relative to receiving such a body shape. Applicant respectfully suggests that the language use originally provided is sufficient, and the present claims are sufficient to overcome any present or past concerns under §101.

As a consequence of the above, Applicant believes they have responded to each concern raised by the Office in this matter and reconsideration and withdrawal of the present rejection is respectfully requested along with notice to that effect.

4. Rejection of claims under 35 U.S.C. §102(b) and (e)

The Examiner has taken the position that claim 14 stands rejected in view of §102(b) as being anticipated in view of Surerus (DT 2329929). Similarly, the Examiner has taken the position that claims 14-19 are rejected under 102(e) as being anticipated in view of Flict (US 6,861,570). While this position is respectfully traverse, no other rejections remain in the application.

37 CFR 1.104 notes that the Examiners action shall be a through investigation and shall be complete with respect to all matters unless otherwise indicated. As a consequence, it is apparent from the written record that claims 20-29 stand neither anticipated nor rendered obvious by the references of record and their other concerns have been otherwise addressed. Claims 20-28 have been recast as being based on an allowable dependent claim and should be allowable for that reason alone. Claim 29 stands non-rejected under 102/103 and should be allowable for that reason alone.

When reviewing both the Sererus reference and the Flick reference the requirements of 102 must be observed, namely that the required elements in the reference must exist in each and every

In Re Application of Christoph KURTH

limitation as noted in the claims. The Examiner, in viewing the discussion in an applied 102 reference must literally apply requirements of the reference itself in the order as noted in the reference without modification or picking and choosing out of the requirements of the reference.

Flick requires a minimum of two layers, the first layer always having conductive fibers and always being electrically conductive and in contact with the skin. The second layer being non-conductive fibers, again with the conductive fibers of the first layer being always in contact with the skin. Flick fails to provide a medical device wherein the skin is covered in direct contact by a non-conductive layer. Flick fails to teach an elastomeric material in direct contact at a contact surface that is electrically insulating. This is not recognized in the Examiner's reading of Flick. It is not sufficient under 102 that such materials may exist, they must be positioned and operate as claimed without modification. This limitation and others were well noted in Applicant's earlier response, the entire contents of which are again incorporated by reference.

Surerus similarly lacks the required limitations in the claims. The present claims require a portion of insulating material between a portion of the conductive members and the cavity. This does not exist in Surerus. The inner wall 5 of Surerus is fully a cellular cushion material that also is graphite and is electrically conductive. As a result the entire inner surface of the cavity in Surerus is fully electrically conductive and in direct contact with the skin in contrast to the present claims and continuously leaks painful electrical charge from the entire surface in contrast to the present invention. This limitation was well noted in Applicant's earlier response, the entire contents of which are again incorporated by reference.

In view of both the above admission on the record of the allowable subject matter regarding the non-rejected claims under 102 and in view of the clear elements lacking from each reference it is respectfully proposed that allowable subject matter exists within the claims and notice to that effect is earnestly solicited.

CONCLUSION

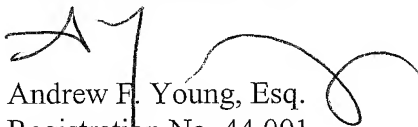
In view of the foregoing, the application is now believed to be in proper form for allowance and notice to that effect is earnestly solicited. Reconsideration and withdrawal of the rejections is also respectfully requested. Applicants propose respectfully that they have responded to each and every rejection and objection raised by the Examiner in this action and no identified matter remains outstanding.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 10-0100. No new matter has been added.

If the Examiner would like to discuss the present application, claims, amendments or other matters, Applicant would appreciate a courtesy call to discuss placing the application in condition for allowance.

Early and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A. Young', with a large, stylized flourish extending to the right.

Andrew F. Young, Esq.
Registration No. 44,001
Attorney for Applicant

Lackebach Siegel, LLP
One Chase Road
Scarsdale, NY 10583
Date: March 7, 2008
MERTE.Y3-17 AMENDMENT TO OF 09-07-07.